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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/245,798	02/05/1999	MIKE O'DONNELL	1690-1-1	5408
996	7590	11/21/2003	EXAMINER	
GRAYBEAL, JACKSON, HALEY LLP 155 - 108TH AVENUE NE SUITE 350 BELLEVUE, WA 98004-5901			ROBINSON BOYCE, AKIBA K	
			ART UNIT	PAPER NUMBER
			3623	

DATE MAILED: 11/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application N .

09/245,798

Applicant(s)

O'DONNELL ET AL.

Examiner

Akiba K Robinson-Boyce

Art Unit

3623

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 47,49-64,72-74,76-80 and 84-93.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s).
10. ☐ Other: _____

Susanna Diaz
Susanna Diaz
Primary Examiner
Art 3623

Continuation of 5. does NOT place the application in condition for allowance because: the applicant argues that in claim 47, Erickson does not specify "an icon comprising a non-verbal representation of a visual object". However, Erickson discloses the Licenseit! button. This button does represent an icon due to the fact that it is a symbol used to link the user to the page where the licensing procedure can be triggered. In this case, the word Licenseit! is the icon since it is not really a word, but a symbol used to link the user to the licensing page. Incorporating a non-verbal representation of a visual object for an icon does not constitute patentable subject matter since an icon is a word or graphic symbol whose form suggests its meaning as described in Webster's Collegiate Dictionary. Also, prior to the amendment filed 11/3/03, claim 84 contained the same matter as claim 47 and was rejected in the same rejection given to claim 47. The addition of having the hotspot viewable in a single window within the document itself and not part of a separate window as data associated with the document does not hold patentable weight to the claim because in computer technology, an icon can be dragged and dropped anywhere within an application. As per claim 57, the applicant argues that the Erickson system does not provide to any client computer a unique license identifier to identify a record with information about a granted license. However, if one looks at Col. 11, line 65-Col. 12, line 11, Erickson talks about Source Work Extensions. These Source Work Extensions allow the licensee to view the Document ID and the permissions mask in the derivative work. These Source Work Extensions are included in the document. The applicant argues that the Source Work Extensions of Erickson do not teach the limitations of claim 57 since a record is not created in response to an acceptance of an offered license. However, in Col. 27, lines 64-Col. 28, line 4 with Col. 28, lines 52-56, it is shown that acceptance of terms are acknowledged prior to the Source Work Extensions being created.

